

#12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hempleman et al)
For: List Building System)
Serial No.: 09/770,882)
Filed: January 26, 2001)
Examiner: Alfred W. Kindred)
Art Unit: 2632)
Docket No. 8376/86291)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date listed below:

RECEIVED

(Date)

FEB 21 2003

DECLARATION OF JAMES D. HEMPLEMAN

Technology Center 2100

I, James D. Hempleman, one of the named inventors of the above identified application hereby declare that:

1. I have been involved in the design, development and management of business information systems for over thirty years.
2. I am a named inventor of two issued U.S. Patents that relate to software based systems, namely 5,038,316 and 6,243,725.
3. I have reviewed and am familiar with the disclosure, figures and pending claims of the above identified application.
4. I have reviewed and am familiar with Contois, US Patent No. 5,864,868.
5. I have reviewed and am familiar with Bernard et al., US Patent No. 5,918,213.
6. I have reviewed and am familiar with an outstanding Final Office action mailed September 23, 2002 rejecting the pending claims of the above identified application.
7. Contois discloses and describes a computer based system for the creation of play lists. The works that are available for selection for inclusion in the play lists are based on a locally available inventory prestored on a hard drive 33 or readable via

local disk drive 28. Contois has no disclosure of automatically downloading from a remote source those works on a play list that are not locally available.

- 7.1 The disk drive 28 disclosed in Contois is, in my opinion, intended to be connected to UART 36 by a cable. It would be local to and in relatively close proximity to the computer 30. Disk drive 28 would not be considered a remote source of works relative to computer 30. Contois does not even describe any functionality for acquiring works off of a disk 26, via drive 28 where those works have not been stored on hard drive 33.
- 7.2 Contois does not disclose, teach, or, suggest the accumulation of information pertaining to those works on a play list which have been presented to a user. Information not addressed or considered by Contois includes, information pertaining to invoicing, billing information, royalty paying or royalty payments, demand analysis or popularity of selected works. In this regard, Contois is completely silent in connection with collecting such information for works on a list which have been presented to a user.
- 7.3 Contois presents works to a user which are listed on a media inventory stored on hard drive 33. Contois is silent with respect to and includes no teaching as to how works not listed on the media inventory can be incorporated into a user created play list.
- 7.4 Contois is completely silent as to advertisements. There is no disclosure, teaching or suggestion in Contois of presenting advertisements to a user. Nor is there any disclosure or suggestion in Contois of downloading advertisements from a remote source for presentation to a user.
- 7.5 Contois is completely silent as to instructions for selecting a plurality of works for a list in accordance with a predetermined performance parameter, such as beats per time-interval.
- 7.6 Fig. 5 of Contois is a song list display screen. Lists are manually created by a user using the screen of Fig. 5.

- 8.0 Bernard et al. is an automated product purchasing system. Fig. 1 of Bernard et al. discloses a telephone based call-in system for the automated purchase of products.
- 8.1 Bernard et al. describe provisions for order fulfillment. In Figs 29, 30 of Bernard et al a customer can specify "rush shipping", see step 2926 Fig. 29 or step 3008 Fig. 30. Col 43, lines 15-24 discuss "rush shipping" of product in connection with Fig. 29. Col 43 lines 39-47 discussing shipping options such as same, next or five day delivery of purchased product.
- 8.2 Fig. 41 Bernard et al disclosed a particular form of a retail store. Even here, physical product delivery is described in Col. 58 line 65-col 59 line 7. This type of process is also illustrated in step 4216 of Fig. 42. The order fulfillment process, step 4216 is described in Col 60, lines 7-29 and describes the customer going to the "order processing center 4116 to pick up the order when it is ready."
- 8.3 Fig. 44 of Bernard et al describes an automated fulfillment process wherein in step 4420 an automated in-store vending machine receives the purchased items such that once "the order is completed, the customer can open an access door and retrieve the selected items." (Col. 61 lines 12-13).
- 8.4 Bernard et al. is completely silent as to the creation and execution of play lists.
- 8.5 Bernard et al., is completely silent as to the collection of billing information, royalty payment information or popularity information pertaining to presented works from a play list.
- 8.6 Bernard et al. does not download works on a user created play list.
- 8.7 Bernard et al. is completely silent as to the creation of play lists and the writing of the works on such lists to a removable medium. Bernard et al. is completely silent as to the establishment of a credit for the purpose of writing works on a list to a removable medium.
- 9.0 I understand that under U.S. Patent Law for a prior art document to anticipate a claim it must disclose all of the limitations of that claim. Further, those limitations must be configured as claimed.

10.0 I have reviewed claim 40 as amended. Unlike claim 40 as amended, Contois requires a user to manually build play lists using the screen of Fig. 5 thereof, one song at a time. Contois has no disclosure of automatically building a list of works in accordance with a selected characteristic. For at least this reason, claim 40 as amended is not anticipated by Contois.

10.1 Claim 43 includes:

"instructions for displaying at least part of the inventory list simultaneously with displaying at least part of the edited list".

In Contois, only the screen of Fig. 5 displays a song list. That screen does not display any of the inventory list as claimed. For at least this reason claim 43 is not anticipated.

10.2 Claim 44 includes:

"instructions for downloading a work not locally available".

As noted above, disk drive 28 of Contois is locally connected to Contois' computer 30. Contois has no disclosure of automatically downloading works on a play list, that are not locally available, from a remote source.

10.3 Claim 45 includes:

"instructions for presenting downloaded advertisements."

As noted above, Contois has no disclosure of downloading works not available locally. Further, Contois is completely silent as to advertisements. Contois system simply does not address "presenting downloaded advertisements" as claimed.

11.0 Claim 67 includes the following limitation:

"second software executable at least in part at the user station for downloading at least some of the works on the list, via a communication network available at least intermittently, from a remote source, to the user's station."

Neither Contois nor Bernard, alone or read together, suggest or make obvious the above limitation. Contois is completely silent as to obtaining works on a play list

that are not locally available. Bernard et al, as noted above, is a product purchasing system where the purchased product is physically delivered to the buyer. Bernard et al do not create play lists. They are silent as to providing missing works on a play list. Bernard et al do not teach or suggest downloading works as claimed above.

- 11.1 For the above reasons, I am of the opinion, because of the above noted differences, that one of skill in designing play list systems would not have found claim 67 obvious given Contois read in view of Bernard et al. My conclusion is also supported by the Examiner's technically incorrect characterization of the disk drive of Contois. Claim 39 requires:

"instructions to download a work on a selected play list wherein the work is not available locally".

In rejecting claim 39, the Examiner stated:

'Contois teaches "download a work on a selected play list (see Fig. 1, whereas the serial MIDI(28) is used to download MIDI files).'

Contois' disk drive is local to and physically near his computer, attached to that computer by a cable. Any work loaded into Contois' computer, via that disk drive, is a locally available work. Contois does not

"download a work on a selected play list wherein the work is not available locally".

As noted above, neither Contois nor Bernard et al have any disclosure or suggestion of downloading works on a list for presentation to a user.

- 12.0 There is no disclosure or suggestion in either Contois or Bernard et alone or in combination directed to the additional limitations of claims 68-70.

Claim 68 adds to claim 67 the limitation:

"wherein at least some of the works are presented at the user station at substantially the same time as they are downloaded".

Claim 69 add:

"wherein at least some of the works are downloaded each time they are presented on the user station".

Claim 70 adds"

"wherein at least one work is downloaded after determining that the work is not available at the user station."

Silence in both Contois and Bernard et al does not make any of the above claims obvious.

13.0 Various pending claims are directed to collecting information as to works on a list that have been presented. These include:

"information used for royalty payments" (claim 72);

"information used to keep track of the popularity of ... presented works" (claim 73)

"information used for billing purposes based on presented works on the list" (claim 84)

Contois collects no information at all relative to presented works. Bernard et al do not in any way address presenting works on a display list. Bernard et al is a product purchasing system which is quite different and unlike Contois or the claimed invention. Nothing in Contois or Bernard et al, alone or read in combination, make up for the complete silence of each to suggest or teach accumulating information as claimed relative to works from a list that have been presented to a user.

14.0 Analogous comments to the above apply to rejected method claims 92-116. For example, claim 92 requires:

"presenting the works on the list to a user, including downloading at least some of the work on the list from a remote source, via a communications network that is available at least intermittently, at a user station."

The above limitation is not addressed at all in Contois which only presents locally available works. As noted above, Bernard et al do not address presenting works on a play list to a user nor "downloading at least some of the works on the

list from a remote source, via a communications network that is available at least intermittently, at a user station." Instead, Bernard et al include a fulfillment system where purchased product is delivered to the purchaser. The complete silence in both Contois and Bernard et al as to the above-quoted limitation from claim 92 does not provide the necessary suggestion or motivation to modify that combination so as to make claim 92 obvious.

14.1 Claim 93 adds to claim 92 the following limitation:

"wherein at least some of the works are presented at the user station at substantially the same time they are downloaded."

Neither Contois nor Bernard et al alone or in combination address a method as in claim 93. No specific suggestion, teaching or motivation has been provided in the rejection of claim 93 which would make the above-quoted limitation of claim 93, including the limitations of base claim 92, obvious.

Similar comments apply to claims 94 and 95 which respectively require:

"wherein at least some of the works are downloaded each time they are presented on the user station." (claim 94). "wherein at least one work is downloaded after determining that the work is not available at the user station." (claim 95).

Neither Contois nor Bernard et al alone or in combination disclose or suggest methods as in claims 94 and 95. As noted above, Contois deals strictly with locally available works. Bernard et al do not address presenting works on a display list for a user. No specific suggestion, teaching or motivation has been articulated in the rejections of claims 94 and 95 relative to modifying Contois in view of Bernard et al so as to make the methods of either one of those claims obvious.

14.2 Claims 97 and 98 are directed to methods for collecting information pertaining to presented works. In this regard, the respective limitations require:

"collecting information pertaining to presented works to be used for royalty-related payments." (claim 97).

"collecting information used to keep track of the popularity of at least some of the works presented to the user." (claim 98).

The rejections of claims 97 and 98 have not provided any specific suggestion, teaching or motivation as to modifying Contois read in view of Bernard et al so as to make the limitations of claims 97 or 98 obvious.

Both of those prior art systems are completely silent relative to the subject matter of the methods of claims 97 and 98.

- 14.3 Claims 109, 110 and 112 are also directly to information pertaining to presented works. These limitations respectively state:

"collecting information used for billing-related purposes based on presented works." (claim 109).

"collecting information used for billing-related purposes based on presented advertisements. (claim 110).

"monitoring one of billing or credit based on presented works." (claim 112).

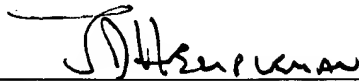
Neither of Contois nor Bernard et al address the subject matter of the above-noted claims. The rejections of those claims included no specific suggestion, teaching or motivation as modifying Contois read in Bernard et al so as to make any of those claims obvious.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

Serial No. 09/770,882

Page 9

punishable by fine or imprisonment or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



James D. Hempleman

2/10/03

Date